

REMARKS

Claims 1 and 3-18 are pending the application; Claims 1 and 3-18 stand rejected under 35 USC §112, and 35 USC §103(a). By this Amendment Claims 1-22 have been cancelled without prejudice, and new Claims 23-37 have been added. These new claims add no new matter to the application; they find support in the originally filed claims and generally throughout the specification as follows:

New Claim	Support in original claim
23	1
24	3
25	4
26	5
27	8
28	9
29	10
30	11
31	12-16
32	12
33	10
34	10 + Fig. 7
35	1
36	1+7
37	1+8+generally in spec

Claims 1-8 and 10-18 stand generally rejected under various section 112 grounds; Applicant respectfully traverses all these rejections. In order to clarify the subject matter which is to be claimed as Applicant's invention, and to expedite an early arrival at an indication of

allowable subject matter, claims 1-22 have been cancelled without prejudice and replaced by new claims 23-37. In view of the replacement of the rejected claims 1-18 by new claims 23-37, all of which have been drafted with due regard for the requirements of section 112, the grounds of rejection are now believed to be moot, and Applicant urges entry of, and early favorable action on, all these new claims. Applicant additionally notes that these new claims introduce no new subject matter not already searched, corresponding as they do to claims already searched, as indicated in the table above.

Claims 1-18 stand rejected, in whole or in part, under 35 USC 103a over the WebCertificate references (WebCertificate.com 1 and 2), and further in view of official notice; Applicant respectfully traverses all these rejections. In order to clarify the subject matter which is to be claimed as Applicant's invention, and to expedite an early arrival at an indication of allowable subject matter, claims 1-18 have been cancelled without prejudice and replaced by new claims 23-37. Applicant additionally notes, as above, that these new claims introduce no new subject matter not already searched, corresponding as they do to claims already searched, as indicated in the table above.

The WebCertificate references (WebCertificate.com 1 and 2) bear publication dates, as noted by the Examiner, of 12/4/98 and 5/20/99, respectively. Neither of these references was published more than one year before Applicant's filing date of 06/02/1999, and are therefore not available as section 102b references, so Applicant assumes they are cited as 102a references in aid of the stated 103a rejection. However, while listed and cited, the WebCertificate.com 1 reference dated 12/4/98 appears to disclose nothing more than a bare gift certificate concept without any enablement disclosure whatever, and indeed, does not actually appear to have been the basis of the Examiner's rejections, at least as indicated by the absence in Examiner's detailed citations in the body of the rejection paragraphs of any page reference citations to WebCertificate.com 1.

Insofar as the Examiner deems WebCertificate.com 1 to have been cited against any of the claims, Applicant traverses and responds that the WebCertificate.com 1 reference is missing some or all of the elements of both the originally rejected claims and of their respective replacement claims, and in particular, WebCertificate.com 1 fails to teach or suggest all of the limitations of new independent claims 23, 29, 34 and 35. New independent claims 23, 29, 34 and 35, and the claims dependent on them, are therefore neither anticipated by WebCertificate.com 1 nor rendered obvious by it, either singly or in combination with any other art of record, and are therefore in condition for allowance.

Therefore, Applicant assumes that it is actually and exclusively the WebCertificate.com 2 reference dated 5/20/99 that is cited against claims 1-18 under section 103a.

However, as shown in the Declaration of Steven C. Robertson filed herewith, together with representative pages 19-24 and 27 from the inventor's lab notebook dated 3/11/99 through 3/13/99 that are attached to his declaration, the inventor actually invented the subject matter of claims 1-18 and there replacement claims 23-37 at least as early as 3/9/99 and then subsequently diligently reduced them to practice either as early as 3/13/99 or not later than the filing of his patent application on 6/2/99. The invention was therefore made on a date earlier (3/11/99) than the cited reference date of 5/20/99, and the WebCertificate.com 2 reference dated 5/20/99 is therefore not available as a section 103a reference to be cited against claims 1-18 or their replacement claims 23-37. Claims 23-37 are therefore believed to be in condition for allowance, and Applicant respectfully urges entry and early favorable action on them.

The inventor, Steven C. Robertson, testifies that at least as early as March 9, 1999 he realized while working in Kent, Washington USA the details of a system for providing an electronic gift certificate service for users over a distributed network. The gift certificate would have a plurality of merchant sites connected to the distributed network, each merchant site running

at least one application to provide an online service to users over the distributed network; a plurality of user computers connected to the distributed network, each user computer running at least one application to access the online service at a merchant site; a gift certificate authority site connected to the plurality of merchant sites, the gift certificate site including a user database and a merchant database, each database containing authentication information as to respective users and merchants, the users accessing the merchant sites from the user computers over the distributed network; a database which stores gift certificate data and transaction data related to particular gift certificates; and an authentication protocol for allowing the gift certificate site to authenticate users and merchants.

This subject matter is essentially the subject matter of both claim 1 and claim 23, and a date of 3/9/99 that is earlier than the constructive reduction to practice date of 6/2/99, and earlier than the cited reference date of 5/20/99, is therefore established for claims 1 and 23.

He further testifies that at least as early as March 9, 1999 he realized while working in Kent, Washington USA the details of a method for a user to purchase a gift certificate from an on-line gift certificate service. The method had the steps of: user enters a desired dollar amount to be applied to the gift certificate; user enters a user-selected PIN for authentication in a gift certificate redemption process; user provides payment information to gift certificate site for purchasing the gift certificate; gift certificate site validates user payment information; and user receives an order confirmation, including a unique gift certificate identification code.

This subject matter is essentially the subject matter of both claim 10 and claim 29, and a date of 3/9/99 that is earlier than the constructive reduction to practice date of 6/2/99, and earlier than the cited reference date of 5/20/99, is therefore established for claims 10 and 29.

This testimony is corroborated by the evidence of his pages 19-24 and 27 from his notebook dated from 3/9/99 to 3/13/99 and attached to his declaration, review of which bears out

his claim to earlier conception of the subject matter later embodied in claims 1 and 10, and 23 and 29, and also new independent claims 34 and 35.

He also testifies that explained to Gale Hurley his gift certificate system and method, just as set forth above, that he began on 3/11/99 showing her the pages of his notebook, and that he finally had her witness the pages formally between 5/9/99 and 5/11/99, also earlier than the cited reference date of 5/20/99. He testifies that he continued to work on the subject matter making needed improvements through 6/2/99 when he filed his patent application.

It is therefore corroborated in accordance with section 131 that the invention was made on a date earlier (3/11/99) than the cited reference date of 5/20/99, and the WebCertificate.com 2 reference dated 5/20/99 is therefore not available as a section 103a reference to be cited against claims 1-18 or their replacement claims 23-37. Claims 23-37 are therefore believed to be in condition for allowance, and Applicant respectfully urges entry and early favorable action on them.

Applicant believes that it has now responded fully to all of the concerns expressed by the Examiner in the Office Action, and respectfully requests that the new Claims be entered and examined, and that early favorable action be taken on all claims pending in the application. If the Examiner has any further concerns, Applicant requests a call to Applicant's new attorney Patrick Dwyer at (206) 343-7074.

Respectfully submitted,



PATRICK MICHAEL DWYER
Reg. No. 32,411

P00-OA.RSP

PATRICK M. DWYER PC
1818 WESTLAKE AVENUE N, SUITE 114
SEATTLE, WA 98109